



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,596	02/26/2004	Daniel Y. Fung	028635-12	4371

25570 7590 12/27/2007  
ROBERTS, MLOTKOWSKI & HOBBS  
P. O. BOX 10064  
MCLEAN, VA 22102-8064

EXAMINER
----------

WONG, ERIC TAK WAI

ART UNIT	PAPER NUMBER
----------	--------------

4172

NOTIFICATION DATE	DELIVERY MODE
-------------------	---------------

12/27/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

Dbeltran@rmhlaw.com  
LGaughan@rmhlaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/786,596	<b>Applicant(s)</b> FUNG ET AL.	
	<b>Examiner</b> ERIC WONG	<b>Art Unit</b> 4172	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/05/2007</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### DETAILED ACTION

1. Claims 1-29 are pending. The following is a non-final first Office action on the merits of claims 1-29.

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 1 provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 11/044,874. Although the conflicting claims are not identical, they are not patentably distinct from each other because there are insubstantial differences between the claims. Both inventions are drawn to a user activating a payment card, submitting a payment request, and deactivating the payment card thereafter. The claim in copending Application No. 11/044,874 is drawn to intended use, ie. at an E-commerce site.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1- 3, 6, 8, 10-11, 14, 16-17, 22-23, 25- 28 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McAllister (US Pat. No. 5,513,250).

**Regarding claim 1:**

McAllister teaches:

- authenticating the user via a device of the user, (see Column 3 lines 1-18)
- transmitting activation information for activating a reusable, pre-existing, unaltered and permanent credit or debit card account number of the user to a financial institution for processing financial transactions, while the user is authenticated (see Column 3 lines 8-18);
- submitting a payment request including the reusable, pre-existing, unaltered and permanent credit or debit card account number to the financial institution from the merchant, while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated (see Column 3 lines 8-18); and

- de-activating the reusable, pre-existing, unaltered and permanent credit or debit card account number after the payment request is processed by the financial institution (see Column 3 lines 8-18);
- wherein the financial institution only accepts and processes payment requests received from merchants while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated, and the financial institution declines payment requests while the reusable, pre-existing, unaltered and permanent credit or debit card account number is de-activated (see Column 3 lines 8-18);

McAllister does not expressly teach authenticating the user via a device of the user while the user is at the merchant (see Figure 1A). McAllister, however, teaches accessing the system by telephone. Examiner asserts that one skilled in the art at the time of invention would have known McAllister to also be accessible by phone at the merchant or a cellular telephone, evidenced by McAllister teaching the invention to be accessible “preferably but not necessarily [by] his residence telephone”.

**Regarding claim 2:**

McAllister further teaches authenticating the user at a server via the device of the user, (see Figure 4 element 1213).

**Regarding claim 3:**

McAllister further teaches authenticating the user with the user device (see Column 3 lines 1-18).

**Regarding claim 6:**

McAllister further teaches wherein the activation information is transmitted from the user device to the server, and the method further comprises transmitting the activation information from the server to the financial institution (see Figure 5 with brief description).

**Regarding claim 8:**

McAllister further teaches wherein the activation information is transmitted from the user device to the financial institution (see Column 3 lines 1-18).

**Regarding claim 10:**

McAllister further teaches creating a unique user name and password for the user at the server; and using the unique user name and password in the authenticating step (see Column 12 lines 40-47)

**Regarding claim 11:**

McAllister further teaches de-activating the reusable, preexisting, unaltered and permanent credit or debit card account number (i) a predetermined amount of time after the user is authenticated or (ii) after the user goes offline from the server (see Column 3 lines 8-18);

**Regarding claim 14:**

McAllister further teaches wherein the payment requests comprises partial payment requests and the method further comprises processing the partial payment requests including generating subsequent activation information for processing remaining payments (see Column 15 lines 48-63).

**Regarding claim 16:**

Art Unit: 4172

McAllister further teaches wherein the user authentication includes at least one of authentication of the user based on a user name and password of the user, authentication of the user based on biometric information of the user, and authentication of the user based on personal identification number information of the user, (see Column 12 lines 40-47).

**Regarding claim 17:**

McAllister further teaches wherein the de-activating of the reusable, pre-existing, unaltered and permanent credit or debit card account number is performed at the financial institution after the processing of the payment request, (see Column 3 lines 1-18).

**Regarding claim 22:**

McAllister teaches reading the reusable, preexisting, unaltered and permanent credit or debit card account number from a card via a card reader device of the merchant for processing the payment request (see Column 13 lines 47-53).

**Regarding claim 23:**

McAllister further teaches wherein the payment request comprises a partial payment request and the method further comprises processing the partial payment request including generating subsequent activation information for processing remaining payments (see Column 15 lines 48-63).

**Regarding claim 25:**

The claim is drawn to a system configured to perform the steps recited in claim 1 (see rejection of claim 1 above).

**Regarding claim 26:**

The claim is drawn to a storage medium storing a computer program for performing the steps recited in claim 1 (see rejection of claim 1 above).

**Regarding claim 27:**

McAllister teaches:

- means for authenticating the user via a device of the user while the user is at the merchant (see Column 3 lines 1-18);
- means for transmitting activation information for activating a reusable, preexisting, unaltered and permanent credit or debit card account number of the user from the user device to a financial institution for processing financial transactions, while the user is authenticated (see Column 3 lines 8-18);
- means for submitting a payment request including the reusable, pre-existing, unaltered and permanent credit or debit card account number to the financial institution from the merchant, while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated (see Column 3 lines 8-18); and
- means for de-activating the reusable, pre-existing, unaltered and permanent credit or debit card account number after the payment request is processed by the financial institution (see Column 3 lines 8-18),



- wherein the financial institution only accepts and processes payment requests received from merchants while the reusable, pre-existing, unaltered and permanent credit or debit card account number is activated, and the financial institution declines payment requests while the reusable, pre-existing, unaltered and permanent credit or debit card account number is de-activated (see Column 3 lines 8-18).

**Regarding claim 28:**

McAllister teaches wherein the means for authenticating, the means for transmitting, the means for submitting, and the means for deactivating comprise devices of a computer system, (see Figure 5 element 250).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister in view of *In Re Venner*, 120 USPQ 192, 194; 262 F2d 91 (CCPA 1958).

**Regarding claim 4:**

*In Re Venner* teaches to make automatic is obvious. It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with wherein the activation information is automatically transmitted to the financial

Art Unit: 4172

institution when the user logs into the server. One skilled in the art would have been motivated to make the modification for the benefit of increased convenience.

5. Claims 18 and 19 rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister in view of Marullo et al. (US Pat. No. 6185701).

**Regarding claim 18:**

Marullo et al. teaches using web services for communicating with a financial institution (see Column 15 lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with wherein the financial institution includes web services for processing the activation information and the user device is enabled to access the web services of the financial institution for transmitting the activation information. One skilled in the art would have been motivated to make the modification because providing a standard interface allows for greater compatibility.

**Regarding claim 19**

Marullo et al. teaches using web services for communicating with a financial institution (see Column 15 lines 55-63). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with wherein the financial institution includes web services for processing the activation information, the user device is not enabled to access the web services of the financial institution, and the method further comprises the user device accessing the server, which accesses the web services of the financial institution for processing the activation information. One

Art Unit: 4172

skilled in the art would have been motivated to make the modification because providing a standard interface allows for greater compatibility.

6. Claims 5 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister in view of Lawlor et al. (US Pat. No. 5220501).

**Regarding claim 5:**

Lawlor et al., not McAllister, teaches wherein the result of the processing of the financial transaction is transmitted to the user via the server (see Column 52 lines 27-53). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with said feature(s). One skilled in the art would have been motivated to make the modification because it is useful to see the result of transactions for the benefit of increased security.

**Regarding claim 24:**

Lawlor et al., not McAllister, teaches pre-authorizing recurring payments (see Column 34 lines 29-35). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with wherein the payment request comprises a recurring payment request and the method further comprises processing the recurring payment request including generating subsequent activation information for processing recurring payments. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

7. Claims 7, 9, 12, 13, 20, 21, 29 rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister in view of Official Notice.

**Regarding claim 7:**

Art Unit: 4172

Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include wherein the activation information is transmitted as one of a secure signal, an encrypted e-mail message, a secure facsimile message, a secure wireless communications message, a secure telephone communications message, a secure SMS message, and a secure web services message. One skilled in the art would have been motivated to make the modification for the benefit of increased security.

**Regarding claim 9:**

Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include wherein the activation information is transmitted as one of a secure signal, an encrypted e-mail message, a secure facsimile message, a secure wireless communications message, a secure telephone communications message, a secure SMS message, and a secure web services message. One skilled in the art would have been motivated to make the modification for the benefit of increased security.

**Regarding claim 12:**

McAllister teaches setting a dollar limit on the purchasing power of the card during the time frame. However, McAllister does not teach creating a unique card with the limited available balance. Examiner notes that at the time of invention both stored value cards and paying for stored value cards with a credit card were old and well known in the art. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include creating a unique credit

Art Unit: 4172

or debit card with a limited available balance based on the reusable, pre-existing, unaltered and permanent credit or debit card account number of the user; and allowing the user to execute financial transactions subject to the available balance using the unique credit or debit card in place of the reusable, pre-existing, unaltered and permanent credit or debit card account number. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

**Regarding claim 13:**

McAllister teaches authenticating the user at the server; and transmitting from the server the activation information to the financial institution for processing of the payment request, wherein the financial institution processes payment requests received from merchants while the unique credit or debit card is activated and declines payment requests while the unique credit or debit card is de-activated.

McAllister does not explicitly teach both online and offline payment requests. At the time of invention it would have been in the knowledge of one of ordinary skill in the art to apply the invention to both offline and online transactions since both often go hand in hand. Accommodating for both types of transactions increases profit for the financial institution because it increases the customer base. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include the financial institution processing both online and offline payment requests wherein the financial institution processes payment requests received from merchants while the unique credit or debit card is activated and declines payment requests while the unique credit or debit card is de-activated. One skilled in

Art Unit: 4172

the art would have been motivated to make the modification for the benefit of increasing the customer base.

**Regarding claim 20:**

At the time of invention it was old and well known in the art to make a payment by phone, ie. the user device. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include transmitting the reusable, pre-existing, unaltered and permanent credit or debit card account number from the user device to a device of the merchant for processing the payment request. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

**Regarding claim 21:**

At the time of invention it was old and well known in the art to store sensitive information on a user device via a secure mechanism. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention to include storing the reusable, pre-existing, unaltered and permanent credit or debit card account number on the user device via a secure mechanism. One skilled in the art would have been motivated to make the modification for the benefit of increased security.

**Regarding claim 29:**

At the time of invention it was old and well known in the art to use a computer readable medium containing instructions to perform a method. Official Notice is taken that it would have been obvious to one of ordinary skill in the art at the time of invention to

Art Unit: 4172

have modified the invention to include wherein the means for authenticating, the means for transmitting, the means for submitting, and the means for deactivating comprise computer readable instructions recorded on a computer readable medium. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

8. Claim 15 rejected under 35 U.S.C. 103(a) as being unpatentable over McAllister in view of Official Notice, further in view of Lawlor et al.

**Regarding claim 15:**

Lawlor et al. teaches pre-authorizing recurring payments (see Column 34 lines 29-35). It would have been obvious to one of ordinary skill in the art at the time of invention to have modified the invention above with wherein the payment requests comprises recurring payment requests and the method further comprises processing the recurring payment requests including generating subsequent activation information for processing the recurring payments. One skilled in the art would have been motivated to make the modification for the benefit of convenience.

**Examiner's Note:** The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC WONG whose telephone number is (571)270-3405. The examiner can normally be reached on Monday-Friday 7:30AM-5:00PM, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/  
Supervisory Patent Examiner, Art Unit 4172

Eric Wong  
Examiner  
Art Unit 4172

Dec 07